

REMARKS

Favorable reconsideration of this application in view of the attachments hereto and the following comments are requested.

I. Procedural Matters

At the outset, the Examiner will note that a formal Notice of Appeal was filed on November 4, 2003 so as to toll the time period running against this application. A formal Request for Continued Examination is being filed concurrently herewith along with a Petition for Time Extension Under Rule 136(a) so as to present new arguments and/or new evidence pursuant to 37 CFR §114.

As a further procedural note, the Examiner will observe that a formal Revocation and Power of Attorney from the assignee of record has been filed in this application, along with a request that the record address be changed so that all Patent Office communications henceforth be directed to the undersigned. The Examiner's assistance to ensure that all future communications in this matter is directed to the undersigned's new address of record will be appreciated.

II. Prosecution History Summary

It may be helpful at this juncture to briefly summarize the prosecution history of this application to date.

In this regard, the Examiner had previously asserted in the first Official action that MIYAMOTO (USP 4,440,827) anticipated the then pending claims. However, MIYAMOTO was withdrawn as a reference in view of the applicants' submission of an

affidavit which established that the paper of the present invention cannot be printed by an ink-jet printing process.¹

In his "final" Official Action dated April 10, 2002, the Examiner then asserted that the pending claims were not novel over SUZUKI (USP 4,298,652). While the SUZUKI patent concerns gravure or flexographic printing process as is the case in the present invention, it employs an inner coat which always contains, as pigment, *natural* ground carbonate – not *precipitated* calcium carbonate (PCC). Data was however, submitted by the applicants in response which showed the printability differences in results obtained by the use of PCC instead of natural calcium carbonate.

In that same "final" Official Action, the Examiner considered that the use of silica in the inner coat was "obvious" (35 USC §103(a)) over the combination of SUZUKI and LEE (USP 6,183,844). Applicant noted in response during continued examination that LEE did not concern rotogravure or photogravure printing process, but a paper intended to be printed by ink-jet printing. In a further Official action dated December 23, 2002, the Examiner accepted the applicants' arguments, but advanced new objections based on the same reference. In their responsive amendment filed march 14, 2003, following a telephonic interview, the applicants submitted a new set of claims which specified that the inner coat *exclusively* contained, as pigment, silica or PCC.

In his latest Official Action, the Examiner has withdrawn his rejection based on SUZUKI and LEE, but instead rejects the claims based on KITAMURA. Therefore, it is the KITAMURA reference which the Examiner now asserts renders "obvious" the presently claimed invention.

¹ See the Escaffre Affidavit submitted with the applicants' response of November 6, 2001.

III. Response to Substantive Rejection

Applicants again request reconsideration and withdrawal of the rejection advanced under 35 USC §103(a) based on KITMURA (USP 6,465,086). Specifically, applicants note in this regard, that the comments in the Examiner's Advisory Action dated August 27, 2003, reveal that neither KITAMURA, nor JP 63104878 ("JP '878") cited in KITAMURA explicitly disclose that the surface coatings thereof must contain silica.

Applicants will not here rehash all the reasons advanced during prosecution to date for patentability of the present invention (which reasons are, nonetheless, expressly incorporated hereinto by reference). Instead, applicants will focus on the Examiner's reasons for maintaining the rejection of record which apparently have been based on an incomplete record copy of the JP '878 reference. A complete English-language translation of the JP '878 reference is therefore attached.²

Applicants note at the outset that the coated paper disclosed in KITMURA is for **ink jet** printing – not for gravure or flexographic printing as in the present invention. Specifically, the evidence of record herein unequivocally demonstrates that the composition of the paper does in fact dictate the type of printing employed. Thus, the Escaffre Affidavit submitted with the applicants' response of November 6, 2001, establishes the art-recognition that it is **absolutely essential** for a paper top coat to include **silica** in order to be capable of being printed by **ink-jet printing**.

Thus, applicants suggest that KITAMURA does not need to *explicitly* state that the therein disclosed coating must contain silica since, as the present record demonstrates, it is absolutely essential for ink-jet printable papers, such as Kitamura, to contain silica. Hence, even if it is assumed that KITAMURA did not explicitly disclose

² A fresh form PTO-1449 which lists the JP '878 reference and its translation is attached for the Examiner's convenience.

that the top coat of the therein disclosed paper must contain silica (which assumption of course is not pertinent since KITAMURA discloses otherwise), the mere fact that KITAMURA discloses the paper to be ink-jet printable is tantamount to an explicit statement that the therein disclosed coating must necessarily always contain silica.

KITAMURA of course discloses that at least one of the layers must include some silica. . In fact, the best results obtained in KITAMURA is when silica is used as pigment in both coats, which of course is not surprising given the fact that the KITAMURA papers are ink-jet printable.³

The Examiner seems to assert that the Abstract of the JP '878 reference did not disclose that the top coat must necessarily contain silica. In order to provide the Examiner with the full and accurate teaching of the JP '878 reference, there is attached hereto a complete English-language translation of the same. As the Examiner will note from page 7, line 5 bridging page 8, line 4 of the translation, the JP '878 in fact discloses a paper which is coated with two layers, wherein **each** layer contains some silica. Indeed, at page 8, lines 3-4 of the translation, the JP '878 reference states that: "...the **difference** in the average diameters **of each layer** should be at least 1 μm , ideally at least 2 μm ." (emphasis added) The asserted improvement disclosed in the JP '878 reference is thus that, in each coating layer, silica particles of different sizes are employed.

Both the KITAMURA and JP '878 publications relate to **ink-jet printing** – and not to gravure or flexographic printing. Thus, for the same reasons advanced during prosecution to date, such publications are totally inappropriate for use as references

³ See discussion, *supra*. and column 8, line 55 of KITAMURA and the Examples therein.

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against the presently claimed invention and clearly do not at all render the claimed invention "obvious".⁴

Finally, it is noted that the term "gravure means" is employed in KITAMURA. However, such language does not in any way suggest to those skilled in this art that "gravure means" is the same as gravure **printing**. Instead, the "gravure means" employed by KITAMURA is for the purpose of coating – **not** for effecting **printing** on an **already coated** paper. To be sure, as discussed above, the papers of KITAMURA are only concerned with **ink-jet printing** – not gravure printing or flexographic printing.

Applicants again assert that the claims presently pending in this application are patentably distinguishable over KITAMURA and the JP '878 reference cited therein for at least the reasons noted above. Therefore, reconsideration and allowance of this application are requested.

Such favorable action is solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



Bryan H. Davidson
Reg. No. 30,251

BHD:lmy
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100

⁴ Applicants further note that the Examiner's withdrawal of MIYAMOTO and LEE references based on their disclosure of papers suitable for ink-jet printing amounts to an acknowledgement that publications such as KITAMURA and JP '878 which deal with ink-jet printing are inappropriate as references against the present application.